

# Notice of Allowability

Application No.

09/251,988

Examiner

Jermele M. Hollington

Applicant(s)

BEAMAN ET AL.

Art Unit

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## -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed on Oct. 31, 2005.
2. ☒ The allowed claim(s) is/are 7,10,41-43,49,50 and 58-60.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☐ All    b) ☐ Some\*    c) ☐ None    of the:
  1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.  
**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
  - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
    - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
  - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

### Attachment(s)

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO-1449 or PTO/SB/08),  
Paper No./Mail Date 04/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413),  
Paper No./Mail Date \_\_\_\_\_
7. ☐ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_

Jermele Hollington

## DETAILED ACTION

### *Information Disclosure Statement*

1. The information disclosure statement (IDS) submitted on April 24, 2006 is being considered by the examiner. However, the cross out references have been previously cited by the examiner or by the applicants.

### *Interference*

2. In MPEP 2301.03, it states: "A claim of one inventor can be said to interfere with the claim of another inventor if they each have a patentable claim to the same invention." The Office practice and the case law define "same invention" to mean patentably indistinct inventions. Case v. CPC Int'l, Inc., 730 F.2d 745, 750, 221 USPQ 196, 200 (Fed. Cir. 1984); Aelony v. Arni, 547 F.2d 566, 570, 192 USPQ 486, 489-90 (CCPA 1977); Nitz v. Ehrenreich, 537 F.2d 539, 543, 190 USPQ 413, 416 (CCPA 1976); Ex parte Card, 1904 C.D. 383, 384-85 (Comm'r Pats. 1904). If the claimed invention of either party is patentably distinct from the claimed invention of the other party, then there is no interference-in-fact. Nitz v. Ehrenreich, 537 F.2d 539, 543, 190 USPQ 413, 416 (CCPA 1976). 37 CFR 41.203(a) states the test in terms of the familiar concepts of obviousness and anticipation. Accord Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wa., 334 F.3d 1264, 1269-70, 67 USPQ2d 1161, 1164-65 (Fed. Cir. 2003) (affirming the Office's interpretive rule). Identical language in claims does not guarantee that they are drawn to the same invention. Every claim must be construed in light of the application in which it appears. 37 CFR 41.200(b). Claims reciting means-plus-function limitations, in particular, might have different scopes depending on the corresponding structure described in the written description."

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Keep also in mind that 37 CFR 41.203 states: "(a) Interfering subject matter. An interference exists if the subject matter of a claim of one party would, if prior art, have anticipated or rendered obvious the subject matter of a claim of the opposing party and vice versa."

Base on the above statement, the examiner believes that there is no interference between the claims of the present invention and claims 1-3 of U.S. Patent 6,033,935 since they do not have a patentable claim to the same invention.

If the applicants believe there is an inference, the following must be provided.

3. Applicants have suggested an interference pursuant to 37 CFR 41.202(a) in a communication filed on Oct. 31, 2005.
4. Applicants failed to (1) identify all claims the applicant believes interfere, and/or (2) propose one or more counts, and/or (3) show how the claims correspond to one or more counts. See 37 CFR 41.202(a)(2) and MPEP § 2304.02(b).
5. Applicants failed to provide a claim chart comparing at least one claim of each party corresponding to the count. See 37 CFR 41.202(a)(3) and MPEP § 2304.02(c).
6. Applicant failed to provide a detailed explanation as to why applicant will prevail on priority. See 37 CFR 41.202(a)(4), (a)(6), (d) and MPEP § 2304.02(c).
7. Claims 7, 10, 42-43, 49 and 58-60 has been added or amended in a communication filed on Oct. 31, 2005 to provoke an interference. Applicants failed to provide a claim chart showing the written description for each claim in the applicant's specification. See 37 CFR 41.202(a)(5) and MPEP § 2304.02(d).

Since the examiner is taking a position that there is no interference, the following is being applied.

***Terminal Disclaimer***

8. The terminal disclaimer filed on Dec. 12, 2004 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of any patent granted on Application No. 10/145,661 has been reviewed and is accepted. The terminal disclaimer has been recorded.

**EXAMINER'S AMENDMENT**

9. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

The application has been amended as follows: In the amending specification filed on Oct. 31, 2005 these are the following changes:

a) On page 2, 2<sup>nd</sup> paragraph, line 3, changing "09/641,667" to --08/641, 667-- to correct the application number, and deleting the last two lines after "US Patent 5,785,538",

b) On page 2, 4<sup>th</sup> paragraph, line 2, after "1996" add --now abandoned--, last line change "now abandoned;" to --now abandoned,-- and adding after that --which is a continuation-in part of US Application Serial No. 08/300,620 filed on September 2, 1994 now issues as US Patent 5,531,022, which is a division of US Application Serial No. 07/963,346 filed on October 19, 1992 now issues as US Patent 5,371,654;,"

c) On page 2, last paragraph, line 2, after "March 11, 1999" adding --now issue as US Patent 6,528,984--,

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d) On page 3, 2<sup>nd</sup> paragraph, line 2, after "March 11, 1999" adding --now issue as US Patent 6,452,406--,

e) On page 3, 3<sup>rd</sup> paragraph, line 2, after "November 20, 1996" adding --now abandoned--

f) On page 3, 4<sup>th</sup> paragraph, line 2, after "August 10, 201" adding --now issue as US Patent 6,722,032--, and in line 6, after "March 12, 1996" adding --now issue as US Patent 5,811,982--, and

g) On page 3, 5<sup>th</sup> paragraph, line 3, changing "08/752,733 filed on December 12, 1997" to "08/527,733 filed on September 13, 1995--", and deleting last two lines after "US Patent 5,810,607".

***Allowable Subject Matter***

10. Claims 7, 10, 41-43, 49-51, and 58-60 are allowed.

11. The following is an examiner's statement of reasons for allowance: regarding claims 7, 10, 41-43, 49-51 and 58-60, the primary reason for the allowance of the claims is due to the filing of a terminal disclaimer, which extend beyond the expiration date of any patent granted on Application No. 10/145,661 as stated above.

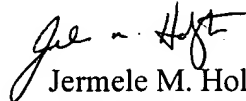
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jermele M. Hollington whose telephone number is (571) 272-1960. The examiner can normally be reached on M-F (9:00-4:30 EST) First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wael Fahmy can be reached on (517) 272-1705. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jermele M. Hollington  
Primary Examiner  
Art Unit 2829

JMH  
May 22, 2006